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EXAMINER

SHRADER, LAWRENCE J

ART UNIT

PAPER NUMBER

2124

DATE MAILED: 02/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/916,958

Applicant(s)

DALTON, KENTON T.

Examiner

Lawrence Shrader

Art Unit

2124

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7 is/are allowed.
- 6) ☒ Claim(s) 8-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to the amendments filed by the Applicant on 10/07/2004.
2. Claims 8 – 20 remain rejected; and claims 1 – 7 are allowable.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 8 – 10, 12, 14; and 15 – 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Draper et al., U.S. Patent 6,604,236.

In regard to claim 8:

"a) providing a computer containing a software tool that maps directory references between the first directory structure and the second directory structure by source name;

Draper discloses a map file referencing the differences between the first and second directory structures (column 2, lines 22 – 29).

b) input the first computer file to the computer;

Draper discloses that the first directory system is stored (Abstract).

Art Unit: 2124

c) identifying source names in a line of the first computer file that are referenced by the software tool;

Draper discloses a map file referencing the differences between the first and second directory structures (column 2, lines 22 – 29).

d) for each identified source name, substituting a second directory associated with the identified source name for each first directory associated with the identified source name."

See Draper column 1, line 49 to column 2, line 6.

In regard to claim 9, incorporating the rejection of claim 8:

"...wherein step (c) is performed by steps of:

c1) comparing the source names in the line to the source names identified by the software tool, and

c2) selecting the directory reference in the first computer file associated with each source name the line that matches a source name identified by the software tool."

Draper discloses comparing a first and second computer-readable directory and identifying the difference between the two directories (column 1, line 49 – column 2, line 6).

In regard to claim 10, incorporating the rejection of claim 9:

"...further comprising steps of:

e) storing the line containing a substituted directory reference to the second computer file, and

f) repeating steps (c) and (d) for each line in the first computer file."

Draper discloses a map file referencing the differences between the first and second directory structures (column 2, lines 22 – 29).

Art Unit: 2124

In regard to claim 12, incorporating the rejection of claim 8:

"...further comprising steps of:

e) storing the line containing a changed directory reference to the second computer file, and

f) repeating steps (c) and (d) for each line in first computer file."

Draper discloses a map file referencing the differences between the first and second directory structures (column 2, lines 22 – 29). See also Draper column 1, line 49 to column 2, line 6.

In regard to claim 14, incorporating the rejection of claim 8:

"...wherein the second computer file overwrites the first computer file."

Draper discloses that a new version of the directory structure is stores replacing the old structure (column 1, line 64 to column 2, line 6).

In regard to claim 15:

"first computer-readable program code for causing the computer identify source names in each line of the first computer-readable file; and

second computer-readable program code for causing the computer substitute the directory reference associated with each source name from the first directory structure to the second directory structure."

Claim 15 (a computer-readable medium) is rejected for the same corresponding reasons put forth in the rejection of claim 8 (a corresponding process).

In regard to claim 16, incorporating the rejection of claim 15:

Art Unit: 2124

"...wherein the computer-readable software tool includes computer-readable data representing source names in the first and second computer-readable directory structures, and the first computer-readable program code further comprises:

computer-readable program code causing the computer compare the source names in the line of the first computer-readable file to the source names represented by the computer-readable data, and

computer readable program code for causing the computer to select the directory reference in the first computer-readable file associated with each identified source name in the line."

Claim 16 (a computer-readable medium) is rejected for the same corresponding reasons put forth in the rejection of claim 9 (a corresponding process).

In regard to claim 17, incorporating the rejection of claim 16:

"...wherein the computer-readable software tool further comprises:

computer-readable program code for causing the computer to store the line containing a changed directory reference to the second computer-readable file."

Claim 17 (a computer-readable medium) is rejected for the same corresponding reasons put forth in the rejection of claim 10 (a corresponding process).

In regard to claim 18, incorporating the rejection of claim 17:

"...wherein the computer-readable software tool further comprises:

computer-readable program code for causing the computer to output the second computer-readable file as defining the integrated circuit in the second directory structure."

Claim 18 (a computer-readable medium) is rejected for the same corresponding reasons put forth in the rejection of claim 11 (a corresponding process).

Art Unit: 2124

In regard to claim 19, incorporating the rejection of claim 15:

"...wherein the computer-readable software tool further comprises:

computer-readable program code for causing the computer store the line containing a changed directory reference second computer-readable file."

Claim 19 (a computer-readable medium) is rejected for the same corresponding reasons put forth in the rejection of claim 10 (a corresponding process).

In regard to claim 20, incorporating the rejection of claim 19:

"...wherein the computer-readable software tool further comprises:

computer-readable program code for causing the computer to output the second computer-readable file as defining the integrated circuit in the second directory structure."

Claim 20 (a computer-readable medium) is rejected for the same corresponding reasons put forth in the rejection of claim 13 (a corresponding process).

5. Claims 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Draper et al., U.S. Patent 6,604,236 (hereinafter referred to as Draper) in view of Yazdani, U.S. Patent 6,625,597.

In regard to claim 11, incorporating the rejection of claim 10:

"...further comprising:

g) output the second computer file as defining the integrated circuit the second directory structure.

Draper discloses a map file referencing the differences between the first and second directory structures (column 2, lines 22 – 29), but does not disclose defining an integrated circuit in a computer-readable directory. However, Yazdani discloses defining an integrated circuit in a computer-readable directory (column 1, lines 9 – 20; and column 1, line 59 to column 2, line 14). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to combine the Draper invention that referenced differences between directory structures with the directories defining integrated circuits as taught by Yazdani because the combination provides a means to update the latest design attributes as taught by Yazdani at column 1, lines 29 – 36.

In regard to claim 13, incorporating the rejection of claim 12:

"...further comprising:

g) output the second computer file as defining the integrated circuit in the second directory structure."

Draper discloses a map file referencing the differences between the first and second directory structures (column 2, lines 22 – 29), but does not disclose defining an integrated circuit in a computer-readable directory. However, Yazdani discloses defining an integrated circuit in a computer-readable directory (column 1, lines 9 – 20; and column 1, line 59 to column 2, line 14). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to combine the Draper invention that referenced differences between directory structures with the directories defining integrated circuits as taught by Yazdani because the combination provides a means to update the latest design attributes as taught by Yazdani at column 1, lines 29 – 36.

Allowable Subject Matter

Claims 1 – 7 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

The prior art discloses providing a first and a second directory for comparison and generating a map file referencing differences to generate software tools as disclosed by Draper U.S. Patent 6,604,236. However, the prior art does not disclose:

Providing a first directory arranged in a structure based on a version of an ASIC design system different from a second version.

Response to Amendment

6. Applicant's arguments filed on 10/07/2004 have been fully considered but they are not persuasive:

The Applicant has argued:

"Applicant's invention employs two directory structures, the original (first) and updated (second) data structures representing two different (original – first, and updated – second) ASIC design systems. Specification, page 8, lines 7-14. The claims are amended to recite the relationship of the version of an ASIC design system to the data structure, thereby further distinguishing from Draper ... Claims 8-14 are directed to the process of updating the IC definition using a software tool create a new computer file for the IC, initially defined by directories in the first directory structure, where new computer file is in directories of the second directory structure and the second ASIC system.

Draper, on the other hand, requires all data be ordered into a fixed hierarchy (structure). Thus, Draper does implicitly nor explicitly disclose

Art Unit: 2124

'a computer process of generating a second computer file that defines an integrated circuit in ... a second directory structure based on a second version of an ASIC design system using a first computer file that defines the integrated circuit in a first directory structure based on a first version of an ASIC design system different from the second version,'

as recited in claim 8. Nor does Draper implicitly nor explicitly disclose that.

'the first computer file contains ... lines [having] source names referencing first computer-readable directories of a first directory structure based in the first ASIC design system, as recited in claim 8.'

Draper's file system map file is based on the file system hierarchy of the original data, not between two directory structures based on different ASIC design systems..." (See REMARKS pp. 10 - 11)

"Claim 15 is directed to the software tool that is used to create the second computer file defining the IC based on the second version of an ASIC design system. Thus, Draper does not implicitly nor explicitly disclose computer useable medium having a computer-readable software tool for

'a computer containing a first computer-readable file that defines an integrated circuit in a first directory structure containing first computer-readable directories based on a first version of an ASIC design system to create a second computer-readable file defining the integrated circuit in second computer-readable directories of a second directory structure based on a second version of an ASIC design system different from the first version,'

nor wherein

'the first computer-readable file contains ... lines [having] source names referencing directories of the first directory structure,'

both as recited in claim 15." (See REMARKS p. 12)

Examiner's Response:

In response to applicant's arguments, the recitation referring to "...based on a second version of an ASIC design system using a first computer file...based on a first version of an ASIC design system different from the second version..." and also "...containing first computer-readable directories based on a first version of

Art Unit: 2124

an ASIC design system..based on a second version of an ASIC design system different from the first version...,” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

The noted recitations are found in the preambles of claims 8, and 15 respectively. The claim language still reads broadly enough in the body of these claims to maintain the rejection based on the applied art.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 2124

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Shrader whose telephone number is (571) 272-3734.

The examiner can normally be reached on M-F 08:00-16:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (571) 272-3719. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lawrence Shrader
Examiner
Art Unit 2124

3 February 2005

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